



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,443	12/09/2004	Yusuke Shimizu	05905-0179	8650

22852 7590 12/17/2008  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
----------

WONG, JEFFREY KEITH

ART UNIT	PAPER NUMBER
----------	--------------

3714

MAIL DATE	DELIVERY MODE
-----------	---------------

12/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/517,443

Examiner

Jeffrey K. Wong

Applicant(s)

SHIMIZU ET AL.

Art Unit

3714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 1 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: The proposed amendments bring forth issues that would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant alleges: "Benoy does not disclose "an optional message," as recited in proposed amended independent claim 18". The Examiner disagrees. There is nothing in the claim language disclosing of such a limitation.

"Benoy also fails to disclose the proposed claim 18 recitation of "said optional message being arranged to be sent from the server device to a terminal device optionally designated in advance by the player." The Examiner disagrees. There is nothing in the claim language disclosing of such a limitation.

"Moreover, because Benoy fails to disclose "an optional message," as recited in Applicants' proposed amended independent claim 18, from which claim 20 depends, Benoy must necessarily also fail to disclose the additional proposed claim 20 recitation of "wherein the optional message is stored on the server device in association with a certain value of points to be acquired by the player before starting the game." For similar reasons, Benoy must also necessarily fail to disclose the additional proposed amendments to claim 23, including "wherein plural ones of the optional messages are stored in relation with certain values of game points, respectively, one of which is given to the player in accordance with a result of the game executed by the player." Indeed, Benoy provides no disclosure corresponding to "a certain value of points to be acquired by the player before starting the game," as recited in proposed amended claim 20, or "certain values of game points," as recited in proposed amended claim 23." The Examiner disagrees. There was nothing discloses of an optional message in the original claim language.

"With respect to claim 25, the Examiner alleges that Benov discloses that "[a] plurality of messages are displayed such as time of reservation and restaurant selections." Office Action, p. 4. However, even if the Examiner's allegation is correct, an assertion to which Applicants do not assent, this disclosure of Benoy does not correspond to the proposed claim 25 amendments, including, inter alia, "wherein said optional message contains plural messages which are stored in relation with certain game stages or statuses as said event designated in advance by the player, respectively." The Examiner disagrees. There is nothing in the claim language disclosing of such a limitation.

"Claim 28, which depends from proposed amended independent claim 18, includes the additional requirement of "an opponent player." Similarly, claim 30, which depends from proposed amended independent claim 24, includes the additional recitation of an "opponent player." However, Benoy provides no teachings of "an opponent player." The Examiner disagrees. There is nothing in the claim language disclosing of such a limitation.

"Finally, with respect to claim 31, Applicants respectfully note that the Examiner neglected to include any citations to Benoy in the rejection of dependent claim 31. Indeed, Benoy does not appear to teach the additional recitations of proposed amended dependent claim 31, including, inter alia, "wherein said designated terminal device is either the other of the plurality of game apparatuses on which the other player plays the game or a mobile terminal device which the other player carries." The Examiner disagrees. There is nothing in the claim language disclosing of such a limitation.

"Therefore, for these additional reasons, Benoy does not support a rejection of independent claims 20, 23, 25, 28, and 30-31. Therefore, dependent claims 20, 23, 25, 28, and 30-31 are allowable for at least these additional reasons." The Examiner disagrees. There is nothing in the claim language disclosing of such limitations at the time of the Office Action.

"Moreover, Benoy also fails to disclose the additional claim 32 recitation of "said optional message being a message arbitrarily prepared or designated by the one player .... " The Examiner disagrees. There is nothing in the claim language disclosing of such a limitation.

"For at least the above-outlined reasons, Benoy fails to disclose all of the subject matter recited in Applicants' proposed amended independent claim 32." The Examiner disagrees. The limitations presented in Claim 32 were not claimed.